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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,797	01/18/2002	Mark C. Myrhum	11739	4271

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT PAPER NUMBER

3711

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/053,797	<b>Applicant(s)</b> MYRHUM ET AL.	
	<b>Examiner</b> Stephen L. Blau	<b>Art Unit</b> 3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-84 is/are pending in the application.
- 4a) Of the above claim(s) 21-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 74-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/27/04, 3/3/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 21-60 and 61-73 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9 April 2004.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 74-80 are rejected under 35 U.S.C. 102(b) as being anticipated by Vincent (5,447,309).

Vincent discloses a head having a crown (Fig. 11) fitting configured to receive an insert (Fig. 25) and a sole plate (Fig. 12) fitting configured to receive an insert (Fig. 25) producing a desired center of gravity.

Very little weight is given to the method of making the head (i.e. weight is lighter, heavier, or medium) since this is an apparatus claim and weight is given to what a head is and not how it is made.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Alternatively, claims 75-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent in view of Helmstetter.

Vincent discloses weights being more or less long, adjusting the weight by increasing the density of the material (Col. 8, Lns. 3-17), and different relative weights (Col. 7, Lns. 1-16).

Helmstetter discloses a method of providing a first wood having a first weight and first vertical center (Figs. 17, 36), analyzing the performance in the form of trying out and determining which is best (Col. 6, Lns. 25-67), providing a second wood having a second weight substantially equal to the first wood weight in the form being the same type of club with only having a local zone located at a different location (Col. 6, Lns. 25-35) and a second vertical center of gravity different from a first vertical center of gravity (Col. 2, Lns. 14-21), analyzing the performance of the second wood (Col. 6, Lns. 25-67),

an external shape of a first wood and a second wood being substantially the same in the form being the same type of club with only having a local zone located at a different location (Col. 6, Lns. 25-35), a first club sole weight being greater (Figs. 17, 36, Col. 5, Lns. 35-50) than a second club sole weight (Fig. 37), and a first club crown weight (Figs. 17, 36) being less than the second club crown weight (Fig. 37)

In view of the patent of Helmstetter it would have been obvious to modify the head of Vincent to have crown or sole weight being lighter, heavier, or medium in order to modify a head's center of gravity to fit the needs of a player.

6. Claims 81-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent in view of Wood.

Vincent lacks a bore sized to receive a hosel fitting affixed to an end of a shaft, a bore oriented so a shaft will have a proper orientation to a head, a fastener in an aperture fastening a shaft to a head, and a sole plate being recessed around an aperture so a fastener does not extend beyond the sole plate.

Wood discloses a bore sized to receive a hosel fitting affixed to an end of a shaft, a bore oriented so a shaft will have a proper orientation to a head, a fastener in an aperture fastening a shaft to a head, and a sole being recessed around an aperture so a fastener does not extend beyond the sole (Fig. 2) in order to have an adjustable lie (Col. 2, Lns. 13-25). In view of the patent of Wood it would have been obvious to modify the head of Vincent to have a bore sized to receive a hosel fitting affixed to an end of a shaft, a bore oriented so a shaft will have a proper orientation to a head, a fastener in

an aperture fastening a shaft to a head, and a sole plate being recessed around an aperture so a fastener does not extend beyond the sole plate in order to have adjustable lie woods.

***Response to Arguments***

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

**Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 9 December 2004

  
**STEPHEN BLAU**  
**PRIMARY EXAMINER**